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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,224

10/26/2001

Ronald P. Sansone

F-399

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7590

12/12/2006

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 12/12/2006

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20061208

Application Number: 10/033,224
Filing Date: October 26, 2001
Appellant(s): Sansone

Ronald Reichman
(Reg. No. 26,796)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed October 10, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Assignee of record, *Pitney Bowes, Inc.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 3 and 5-17 are pending, rejected, and appealed.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(Two after-final amendments have been filed and entered.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 3 and 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. (US 5,485,369), in view of Godin et al. (US 5,890,138).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 5,485,369	Nicholls et al.	1/1996
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US 5,890,138	Godin et al.	3/1999
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Official Notice	That it is well known to those of ordinary skill in the art that shipping services are available at retail kiosks.	
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Admitted Prior Art

That “The prior art does disclose a non-scale-based weight for use as an input in a shipping application that transmits a query from a routine to a database for a weight associated with a corresponding article, packing material, and a container; returning the weight to the routine; and displaying the cost to ship the article, packing material and container” (appellant’s brief at page 4, lines 3-7).

(9) Grounds of Rejection

I. Claims 3 and 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. (US 5,485,369), in view of Godin et al. (5,890,138).

Nicholls et al. anticipate all the substantive elements of claims 3 and 5-17, except that, while Nicholls et al. do disclose scanning the UPC barcode of an article being picked in a warehouse for shipping, Nicholls et al. do not disclose using the scanned UPC barcode as a key value to look up the weight of the item in a database, thereby obviating the need for a scale to weigh the item. Less significantly, Nicholls et al. disclose that their invention is applicable to any shipping system, but do not specifically disclose a retail kiosk shipping center embodiment, and do not specifically disclose that their network connection to the outside world is the Internet.

However, Godin et al. disclose a shipping method which indeed uses the UPC barcode value for an item to look up the weight of the item in a computer database in order to use that

weight value as one of the necessary inputs to calculate shipping costs for the item, and the system of Godin et al. works over the Internet.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system and method of Nicholls et al. so as to determine the weight of an item to be shipped by using the UPC barcode to look up the weight of the item in a database rather than by measuring the weight with a scale, as well as to work over the Internet, all in accordance with the teachings of Godin et al., in order to eliminate the need to re-measure the weight of identical items each time one of those identical items was being shipped, and in order to work with any terminal in the world connected to the Internet, thereby saving time and effort.

Regarding the retail kiosk embodiment, such shipping centers are certainly well known in the art, hence, an obvious embodiment to be comprised by any generic improvement to shipping centers generally. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the shipping system and method of Nicholls et al. so as to comprise a retail kiosk embodiment, since so doing could be performed by any person of ordinary skill in the art with neither undue experimentation, nor risk of unexpected results.

Further details of the dependent claims would all be either inherent in the described combination, or else self-evident or well known, hence obvious, to one of ordinary skill in the art, such that it would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have made any necessary modifications, merely as a matter of design choice, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

(10) Response to Argument

I. Claims 3 and 5-17 are unpatentable under 35 U.S.C. 103(a) for being obvious over Nicholls et al. (US 5,485,369), in view of Godin et al. (5,890,138).

A. Regarding the argument that Godin et al. discloses a product weight as part of the shipping cost, but fail to disclose anything about the packing material and container, Godin et al. disclose calculating the shipping costs to ship the product, which calculations, to be performed, would necessarily, thus inherently, require that the total shipping weight be known, and the total shipping weight would obviously include the weight of the packing material and container.

B. Regarding the argument that Godin et al. fail to disclose how to determine the weight of the package and, therefore, the cost of mailing the package, Godin et al. indeed determine the cost of shipping the package, which determination indeed requires that the weight of the package be known, as discussed above. As far as determining the weight of the package, Godin et al. indeed disclose how to determine the weight of the package--they look it up in the database. See, for example, column 3, lines 21-52.

C. Regarding the argument that Godin et al. fail to disclose transmitting a query to a database for a weight associated with shipping a product, returning the weight value, and displaying the cost to ship the article, Godin et al. indeed disclose such functionality. See, for example, column 7, lines 8-9, which mentions displaying the cost to ship the article, which would necessarily, thus inherently, require the system to know the total shipping weight of the article, as discussed above, and column 3, lines 21-52, wherein Godin et al. disclose that the necessary weight information is retrieved from a database.

D. Regarding the argument that the prior art fails to disclose calculating the *weight* of the packing material by calculating the empty space/*volume* inside the container (i.e., the volume of the container minus the volume of its contents) and *multiplying* that space-to-be-filled *volume* by the *density* of the objects to fill it (e.g., Styrofoam peanuts, or whatever), multiplying density by volume in order to calculate a weight is well known, hence obvious, to those of ordinary skill in the art. Therefore, as applied in the rejection, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made the recited calculations in order to calculate the desired result, the weight of the packing materials, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

E. Regarding the argument that the prior art does not disclose isolating the containers that do not have the proper postage, such functionality is inherent in the prior art methods because all carriers necessarily confirm/check the weight/postage/size of the packages they receive, in order to verify that they have been paid the proper postage, and identify/return (i.e., isolate) the ones that are found to not have the correct postage.

As for investigating to determine the correct weight when an incorrect weight is found, including inquiring of the manufacturer, determining the correct value when a value thought to be known is determined/identified as being incorrect, and inquiring of a manufacturer for the value, as well as pursuing other avenues of investigation, such functionality is well known, hence obvious, to those of ordinary skill in the art. Therefore, as applied in the rejection, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have made the recited investigations in order to obtain the correct, desired result, the total weight of the package, so that future problems could be avoided, and since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

(11) *Related Proceeding(s) Appendix*

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




12/8/06


Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

December 8, 2006

Appeal Conference Held:


Alex Kalinowski
Supervisory Patent Examiner
Group Art Unit 3627


Sam Sough
Supervisory Patent Examiner
Appeal Conference Specialist
Technology Center 3600

Application: 10/033,224

Paper No. 20061208

Art Unit: 3627

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